

REMARKS

This Amendment is responsive to the Office Action mailed November 21, 2007. By this Amendment, Applicant amends claims 1, 19-20, and 53. Claims 1-59 are pending; claims 1-5, 9-11, 14, 15, 18-20, and 53-55 are under consideration; and claims 6-8, 12, 13, 16, 17, 21-52, and 56-59 are withdrawn.

Reconsideration and withdrawal of the rejections made in the above-referenced Office Action are respectfully requested in view of the following amendments and remarks. Support for the amendments as filed can be found in the specification and claims as filed, e.g., original claims 1 and 53; page 3, line 22 through page 4, line 14; page 27, lines 1-12; as well as Figures 3-6.

Election/Restriction

Applicant thanks the Examiner for reconsideration of the requirement for election/restriction set forth in the paper mailed August 27, 2007. Applicant notes that the restriction requirement is made final, but is allowing claims 6-8, 12, 13, 16, 17, 21-52, and 56-59 to remain pending, subject to rejoinder at the Examiner's discretion.

Information Disclosure Statement

Applicant thanks the Examiner for acknowledgement of receipt of the Information Disclosure Statement filed September 23, 2004. Applicant also thanks the Examiner for considering all of the documents listed in said Information Disclosure Statement, and for indicated such consideration with an electronic signature as well as an initialed notation at the bottom of the document.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 1-5, 9-11, 14, 15, 18-20, and 53-55 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicant has amended claims 1 and 53 to render the claims even clearer and more definite. However, Applicant's amendment does not express any agreement or acquiescence with the rejection of record.

Claim Rejections – 35 U.S.C. § 102(b)

The Office Action rejects claim 1 under 35 U.S.C. § 102(b) as allegedly anticipated by Dresdner et al. (U.S. Patent No. 5,357,636; hereinafter "DRESDNER").

Applicant submits that the claims define novel subject matter. Claim 1 recites:

[a] multi-layered prophylactic article comprising:

- (i) an elastomeric base layer including an internal and an external surface and
- (ii) an anti-friction layer comprising:
 - (a) a polymeric material with an internal surface and an external surface facing the internal surface of the base layer; and
 - (b) regularly recurring raised areas or recesses of an irregular shape, produced by rapidly removing liquid from the anti-friction layer, such that a lower limit of 20% and an upper limit of 95% of the total number of recesses extends through the entire thickness of the anti-friction layer; and
- (iii) particles with a diameter having an upper limit of 500 μm and a lower limit of 10 μm and which contain at least one active substance and/or dye inside and positioned in at least one of the following: between the base layer and the anti-friction layer or a part region thereof, in the anti-friction layer or a part region thereof, on the internal surface of the anti-friction layer or a part region thereof, or within a layer incorporating the at least one active substance and/or dye in at least a part region between the base layer and the anti-friction layer.

DRESDNER discloses a medical glove having an impermeable wall with outer layer and an inner layer; however DRESDNER does not disclose the claimed invention. For example, DRESDNER discloses a medical glove having an impermeable wall with an outer layer and an

inner layer; however DRESDNER does not disclose that one of these layers is a base layer or an anti-friction layer as claimed. Furthermore, while DRESDNER discloses recesses as formed in any glove as the touch between any two fingers, DRESDNER does not disclose raised areas or recesses in an anti-friction layer as described in the instant claims. For at least these reasons, DRESDNER does not anticipate the claims 1-5, 9-11, 19, 20, 53 and 54, and Applicant respectfully requests withdrawal of the rejection.

Claim Rejections – 35 U.S.C. § 103(a)

The Office Action rejects claims 1-5, 9-11, 14, 15, 18-20, and 53-55 under 35 U.S.C. § 103(a) as allegedly unpatentable over HAMANN (U.S. Patent Application Pub. 2004/0091504; hereinafter “HAMANN”) in view of SCHALLER et al. (EP 0824896; hereinafter “SCHALLER”) and in view of BUSNEL et al (U.S. Patent 5,024,852; hereinafter “BUSNEL”).

Applicant submits that HAMANN, SCHALLER, and/or BUSNEL, either alone or in combination, do not disclose or suggest the instant invention. For example, HAMANN does not disclose active substances *inside* particles. HAMANN also does not disclose an anti-friction layer comprising recesses.

BUSNEL also fails to disclose recesses in an anti-friction layer. Moreover, while BUSNEL discloses a prophylactic device having microcapsules, the document does not, for example, disclose the size of the microcapsules. Furthermore, BUSNEL does not teach alternative positioning of the microparticles, e.g., BUSNEL fails to disclose microparticles present on the internal surface of an anti-friction layer or a part region thereof, or in an anti-friction layer or a part region thereof.

SCHALLER also fails to disclose microcapsules comprising an active agent or dye inside.

In addition, one of ordinary skill in the art would not have been motivated to combine HAMANN, BUSNEL, and SCHALLER for at least two reasons. First, SCHALLER does not disclose using active substances enclosed in microcapsules, much less a method wherein a multi-layer prophylactic article is dipped in such microcapsules as the Office Action suggests. Second, SCHALLER discloses the formation of raised areas or recesses of an irregular shape produced by rapidly removing liquid from the anti-friction layer. This step occurs at the end of the manufacturing process, i.e. after the particles presumably containing the at least one active substance and/or dye inside would have been positioned between the base layer and anti-friction layer (or a part thereof) or in the anti-friction layer (or a part thereof) as recited. With the particles already in position, one of ordinary skill in the art would not have been motivated to dip the article in a solution of active compounds, as stated in the Office Action.

For at least the foregoing reasons, Applicant submits that HAMANN, SCHALLER, and/or BUSNEL, either alone or in combination, do not disclose or suggest the instant invention, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103.

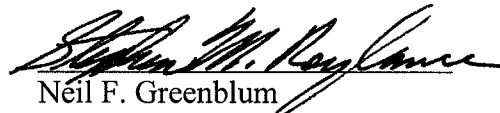
Conclusion

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow all the pending claims.

No additional fee is believed due at this time. If, however, any additional fee is necessary to ensure consideration of the submitted materials, the Patent and Trademark Office is hereby authorized to charge the same to Deposit Account No. 19-0089.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully submitted,
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